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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,715	03/19/2002	Alex Roche	B-4537PCT 619589-5	7580

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EXAMINER

ALLEN, WILLIAM J

ART UNIT	PAPER NUMBER
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3625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/088,715	ROCHE, ALEX	
	Examiner	Art Unit	
	William J. Allen	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 32-43 is/are pending in the application.
- 4a) Of the above claim(s) 32-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Newly submitted claims 32-43 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Group I, claims 1-15, drawn to a method of operating an online retailing operation for retailing of at least one print product to a customer, said print product supplied by a print merchant.

Group II, claims 32-43, drawn to a method for automatic operation of an online print merchant.

The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

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Group II incorporates such special features as “offering a direct service to business customers for generating and ordering print products out of their own content” and “fulfilling print orders from content retailers according to item (i) above and from business customers according to item (ii) above via a plurality of print service providers each using print manager software, a plurality of printers and a plurality of couriers to deliver print products to retail and/or business customers” not incorporated into Group I.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 32-43 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection. Applicant's amendment has necessitated the new grounds of rejection.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-3, 6-7, and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle (US 6133985) in view of von Rosen (US 6493677).**

Regarding claims 1 and related claim 13, Garfinkle teaches:

displaying a plurality of image items for online viewing by said customer at a content retailer web site operated by or for a content retailer (see at least: col. 2 line 64-col. 3 line 4, col. 3 lines 19-21 and 62-67, col. 4 lines 1-6 and 61-66, col. 5 lines 7-13, col. 7 lines 5-16 and 45-49). The Examiner notes that the scanning center and image server are accessed through interface B and constitute a “content retailer”;

transacting an order of a first type between said customer and said content retailer for supply of said at least one print product based on said customer ordering said at least one print product after viewing at least one of said image items at said content retailer (see at least: col. 5 lines 7-13 and 25-34, col. 7 lines 5-16 and 45-49, Fig. 5→5A(note 5D)→5D→5E(note element 5o)); The Examiner notes that the user access the scanning center/image server through interface B to place and order, the order being stored on the server for transfer to the fulfillment center;

transacting an order of a second type between said content retailer and said print merchant for fulfillment of said first type order by said print merchant (see at least: col. 9 lines

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17-21 and 25-28, Fig. 5E (note #5o)); The Examiner notes that order placed through interface B are stored on the image server and transferred to the fulfillments center (i.e. print merchant).

Additionally, despite Garfinkle teaching where the fulfillment center “fulfills, charges, and delivers” an order (see at least: col. 3 lines 21-23), and further where the order may “be delivered by standard mail” (see at least: col. 9 lines 34-35), Garfinkle does not expressly teach *transacting an order of a third type between said print merchant and a print service provider for shipping said at one print product ordered by the customer pursuant to said first type order*.

In the same field of endeavor, von Rosen teaches a system allowing users to submit digital images, edit and customize those images, and have those images branded (i.e. printed) on merchandise labels (see at least: abstract). In addition, von Rosen further teaches *transacting an order of a third type between said print merchant and a print service provider for shipping said at one print product ordered by the customer pursuant to said first type order* (see at least: Fig. 10B and 13B, col. 5 lines 55-63). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Garfinkle to have included *transacting an order of a third type between said print merchant and a print service provider for shipping said at one print product ordered by the customer pursuant to said first type order* as taught by von Rosen in order to provide a system that for creating and ordering customized branded merchandise over a computer network that advantageously automates the production of the merchandise and the shipping of the merchandise to the customer upon confirmation of the order (see at least: von Rosen, col. 2 lines 1-12, Fig. 13B).

Regarding claims 2-3 and 6-7, Garfinkle in view of von Rosen teaches:

(2) *wherein said step of transacting an order of a first type comprises: receiving a specification of said print products from said customer, said specification comprising data selected from the set, media size; media type; number of copies; delivery name; delivery address; ink type* (see at least: Garfinkle, abstract, col. 7 lines 11-16, col. 9 lines 29-35, Fig. 5D-5E).

(3) *wherein said step of transacting an order of a first type comprises receiving a specification of said print products from a customer terminal, in the form of an electronically transmitted data file* (see at least: Garfinkle, col. 3 lines 1-4 and 58-61, Fig. 5E(note # 5o)).

(6) *receiving a price data from said print merchant* (see at least: Garfinkle, 5D (note 5h)).

(7) *obtaining an electronic image data describing a said image item; said electronic image data obtained via a communications network; and electronically sending said electronic image data to said print merchant* (see at least: Garfinkle, col. 3 lines 1-4 and 58-61, col. 9 lines 17-21 and 25-28, Fig. 5E (note #5o)).

Regarding claims 11-12 and 14, Garfinkle teaches all of the above as notes and further teaches the collection of shipping and billing information from the user placing a print order. Garfinkle also teaches where the billing information based on the delivery option selected and print price (see at last: Fig. 5D-5E). Garfinkle, however, lacks the aspect of *itemizing* the various prices/costs on a presented bill. Von Rosen teaches a system allowing users to submit digital images, edit and customize those images, and have those images branded (i.e. printed) on merchandise labels (see at least: abstract). Von Rosen also teaches *itemization* of the presented

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bill including distinctly/separately showing the shipping (i.e. delivery) cost as well as the purchase price (see at least: Fig. 10A-11B). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Garfinkle to have included *itemization* of various costs including delivery price and print price as taught by von Rosen in order to provide a system that displays a summary of an order including a short description of the order and permit a user to return to any previous page to correct any incorrect items (see at least: von Rosen, col. 10 lines 59-67).

3. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle in view of von Rosen, as applied to claims 1-3, 6-7, and 11-14, further in view of Blumberg (US 20030140315).

Regarding claim 4, Garfinkle in view of von Rosen teaches all of the above as noted and further teaches wherein said step of transacting an order of a second type comprises the steps: sending an order to said print merchant, specifying details of said print products (see at least: col. 5 lines 7-13 and 25-34, col. 7 lines 5-16 and 45-49, Fig. 5→5A(note 5D)→5D→5E(note element 5o)). Garfinkle in view of von Rosen, however, does not expressly teach receiving confirmation of said order from said print merchant. In the same field of endeavor, Blumberg teaches receiving confirmation of said order from said print merchant (see at least: 0003, 0062, 0112, 0114, 0116). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Garfinkle in view of von Rosen to have included receiving confirmation of said order from said print merchant as taught by Blumberg in order to provide an on-line printing service that a user can preview multiple styles without the need for the user to have to envision how his own text and graphics would appear inserted into a reference sample and without the need for the printing company to run off physical samples in multiple styles that include an easy means of order confirmation such as email (see at least: Blumberg, 0003, 0104).

Regarding claim 5, Garfinkle in view of von Rosen in view of Blumberg teaches *wherein said step of sending an order to said print merchant comprises sending said order in the*

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form of an electronically transmitted data file (see at least: Garfinkle, col. 3 lines 1-4 and 58-61, Fig. 5E; Blumberg 0006, 0062, 0176, 0212, Fig. 6).

4. Claims 8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle in view of von Rosen, as applied to claims 1-3, 6-7, and 11-14, further in view of Arnold et al. (US 6016504, herein referred to as Arnold).

Regarding claims 8 and 15, Garfinkle in view of von Rosen teaches all of the above as noted and teaches the relationship between scanning center, fulfillment center, and delivery service (see at least: Garfinkle, col. 2 line 64-col. 3 line 4, col. 3 lines 19-21 and 62-67, col. 4 lines 1-6 and 61-66, col. 5 lines 7-13, col. 7 lines 5-16 and 45-49, Fig. 5-5E; von Rosen col. 5 lines 55-63). Though Garfinkle in view of von Rosen teaches these relationships between a scanning center, fulfillment center, and delivery service (i.e. a *content retailer, print merchant, and print service provider*), it does not specifically teach *a contract* between the entities and *storing the contract electronically*. Arnold teaches establishing a contract relationship between a virtual outlet (i.e. retailer) and a merchant (see at least: abstract, col. 11 lines 35-43). More particularly, a virtual outlet and merchant enter into a contract with the contract being stored electronically (col. 10 lines 32-34, col. 11 lines 35-43, col. 13 lines 51-57, Fig. 9, 11, and 20). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Garfinkle in view of von Rosen in view of 892u to have included *storing an electronic contract* as taught by Arnold in order to allow the merchants, retailers, etc.

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involved to easily access and change the terms of the contract if desired (see at least: (col. 10 lines 32-34, col. 11 lines 35-43, col. 13 lines 51-57, Fig. 9, 11, and 20).

5. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle in view of von Rosen in view of Arnold, as applied to claims 8 and 15, and further in view of PTO 892 reference U.

Regarding claims 9-10, Garfinkle in view of von Rosen in view of Arnold teaches all of the above as noted and teaches the relationship between scanning center (retailer), fulfillment (merchant) center, and delivery service (print service provider), and further teaches where a contractual agreement exists between the retailer and the merchant (see at least: Garfinkle, col. 2 line 64-col. 3 line 4, col. 3 lines 19-21 and 62-67, col. 4 lines 1-6 and 61-66, col. 5 lines 7-13, col. 7 lines 5-16 and 45-49, Fig. 5-5E; von Rosen col. 5 lines 55-63; Arnold, abstract, col. 11 lines 35-43). Garfinkle in view of von Rosen in view of Arnold, however, does not expressly teach the contract defines a relationship between the retailer and the merchant in respect to at least one of *a definition of a print product, a special discount available to the content retailer, or a plurality of prices for said print products*. PTO 892 U teaches magazine publishers (i.e. a content retailer) dealing with service providers such as printers/print vendors (see at least Paragraph 1). The publisher is able to receive benefits such as volume discounts/price concessions from the vendor for providing business not traditionally received by the vendor. Vendors are able to give the publisher the price concessions/volume discounts knowing that they will receive business from a publisher as part of a deal (i.e. contract) for a given time period such

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as 3 years (see at least: Paragraphs 23-26). Thereby, PTO 892 U teaches where a contract defines a relationship between the retailer and the merchant in respect to at least one of *a definition of a print product, a special discount available to the content retailer, or a plurality of prices for said print products*. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Garfinkle in view of von Rosen to have included *a contract between a content retailer and a print merchant* as taught by 892u in order to provide a mutually beneficial agreement that provides for volume discounts/price concessions to a content retailer while assuring a print merchant receives guaranteed business that otherwise it would not receive (see at least: 892u, Paragraph 25). The Examiner notes that the price is determined based on the agreement.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William J. Allen
Patent Examiner
March 27, 2007


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